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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/691,392	10/17/2000	Ronald A. Katz	244/068	3722

29129 7590 02/27/2006

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EXAMINER

MCALLISTER, STEVEN B

ART UNIT PAPER NUMBER

3627

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/691,392

Applicant(s)

KATZ ET AL.

Examiner

Steven B. McAllister

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-213 and 215-219 is/are pending in the application.
- 4a) Of the above claim(s) 1-20,24-35,37,38,41,51-67,72-74 and 76-197 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-23,36,39,40,42-50,68-71,75,198-213 and 215-219 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some.* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/2005, 8/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/30/2005 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 44, 45-49, 69-71, 75, 204-207, 214-216, 220-223 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 44, it recites "a geographic identifier", but such an identifier has already been recited in claim 21. It is unclear whether this refers to a second identifier or to the identifier recited in claim 21.

As to claims 45-49, 69-71 and 75, these claims depend from claim 0, which does not exist. Since application of prior art to the claims would require substantial speculation as to the scope of the claims by the examiner, no art rejection was applied. The lack of an art rejection should not be interpreted as an indication of allowability.

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As to claims 204-207, “the geographic location” lacks antecedent basis.

Claims 214 and 220-223 were canceled in a prior amendment, and appear to be shown as “previously presented” or “currently amended” in the current amendment. These claims are not further considered.

Claims 215 and 216 are indefinite since they depend from a canceled claim. Since application of prior art to the claims would require substantial speculation as to the scope of the claims by the examiner, no art rejection was applied. The lack of an art rejection should not be interpreted as an indication of allowability.

Note Regarding Examination

It is noted that the disclosure of application 09/505,619 does not appear to provide enabling support for the amended claims. In a review of that disclosure, it appears that “utilizing at least in part the combination of the geographic descriptor ... and the further data element to select among multiple items available for that geographic descriptor...” is not shown or enabled.

In examining the amended claims, the filing date of the present application was therefore determined to be the effective filing date.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 21-23, 39, 40, 43, 44-46, 50, 68-71, 198-211, 217 are rejected under 35

U.S.C. 102(e) as being anticipated by Fano (6,317,718).

Regarding independent claim 21, Fano discloses a method for providing offers of a good, a service or information, utilizing an electronic communications device, between an offeror and a user of the electronic communication device, comprising the steps of: establishing communication via the electronic communications device between the offeror and buyer; obtaining primary transaction data including geographical information and user identity information; using the identity of the user to determine at least one additional data element (e.g., items the user is interested in purchasing); utilizing at least in part the combination of geographic descriptor of the user and the further data element to select among multiple items available for the geographic descriptor to determine an offer for a good, service or information, and offering an item to the user.

Regarding independent claims 68-71, it is noted that Fano shows all elements above and further shows that the primary transaction information includes an identity of at least one specific good comprising e.g., the item being shopped for.

Regarding independent claims 217 and 218, Fano shows all elements above and further shows using the identity of the user to select from among items since the user profile is keyed off the identity of the user.

As to claims 22 and 23, the electronic communication device (PDA) is a wireless phone.

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As to claim 39, the offeror system contacts the user via the electronic communications device (see Figure 26).

As to claim 40, Fano shows that the determination of an offer is subject to negative decision criteria since the user does not have to purchase offers made via the system.

As to claim 43, the offer is made visually to the user (see visual display in Figure 27).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 36 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fano in view of Kolls (6,389,337).

Fano discloses all of the elements as set forth above except that (claim 36) the offer comprises a coupon; and (claim 42) the offer is made orally to the user.

Kolls teaches the use of e-commerce method utilizing a wireless phone (312) to offer a coupon (see ABSTRACT line 13), wherein the offer is made orally to the user (via element 124).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fano with the use of a wireless phone device that offered coupons orally as taught by Kolls, because some potential customers may not have access to a PDA and a wireless phone can receive offer information and then present the offer orally, wherein using a wireless phone increases the number of customers that would have access to the system. Utilizing a coupon as an offer provides an attractive incentive to promote customer acceptance of an offer.

Claims 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fano in view of U.S. Patent No. 6,434,532 (Goldband et al.).

If it is held that Fano fails to inherently disclose an offer that is time limited, then Goldband et al. is relied upon to teach the use of a time-limited offer (see ABSTRACT, lines 23-24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fano with a time-limited offer as taught by Goldband et al., because time-limited offers expedite the response of the customer to accept an offer.

Claims 47-49, 212, 213, 215, 216, and 219 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fano.

As to claims 47-49, Fano shows all elements of the claims except the particular method of obtaining the geographic descriptor information. However, the examiner notes that the subject matter of claims 47-49 are obvious variants of the methods of obtaining the geographic descriptor data recited in claims 45 or 46. It would have been an obvious matter of design choice to use any of the methods recited in claims 47-49 since it is not

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disclosed that the particular method of obtaining the data solves any particular problem or is for a particular purpose, and it appears that the method would function equally well with either method.

It is noted that if it determined that the claimed subject matter is not merely an obvious variant, a species requirement would be necessary.

As to claims 47, 212, 213, 215, 216, and 219, Fano fails to show utilizing data representing the identify of the user (e.g., a phone number via ANI) to obtain data representing the geographic position of the user.

Malackowski et al. teaches the use of advertising system that sends advertisement to user via wireless telephone utilizing ANI data to determine a geographic identifier of the user (see column 11, lines 39-44).

It would have been 'obvious to one of ordinary skill in the art at the time the invention was made to modify Fano with wireless ANI data as taught by Malackowski et al, because utilizing a wireless phone extends the geographic range of communication between the user and the advertiser.

Regarding claims 48 and 49, Fano fails to expressly disclose a user or an operator manually entering geographic information.

The Examiner takes Official Notice that it was old and well known in the art at the time the invention was made to manually enter geographic identifying information by a user and an Operator.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fano with manually entered location data as is well known in the art, because manually entering the location reduces the operating expense of the advertiser to provide the hardware and software required to electronically determine the location of a user.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

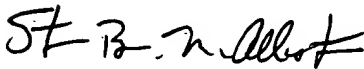
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (571) 272-6785. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander G. Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Steven B. McAllister

Steven B. McAllister
Primary Examiner
Art Unit 3627

STEVE B. MCALLISTER
PRIMARY EXAMINER